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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,650	01/13/2005	Rinaldo Husler	II/2-22717/A/PCT	9350
324	7590	12/14/2009	EXAMINER	
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			MCLENDON, SANZA L	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			12/14/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/521,650	Applicant(s) HUSLER ET AL.	
	Examiner Sanza L. McClendon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3

- 10521650 - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 9, 15 and 17-201 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 17-19 is/are allowed.
- 6) ☒ Claim(s) 9 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In response to the Amendment-After-Final received on November 23, 2009, the examiner has carefully considered the amendments. The examiner acknowledges the cancellation of claims 10-11, 16, and 21.

Response to Arguments

2. Applicant's amendment filed November 23, 2009 has been fully considered but they are not persuasive. Applicant appears to be relying on the amendment positively stating the lamp output of at least 120 W/cm. However, the indicated allowability of claim 21 as found in the previous office action has been withdrawn, since it appears said indication was premature. After reconsideration of both references used in the rejections. It appears that while Felder et al sets forth UV lamp devices having a lamp output of 80 W/cm, the secondary reference (Gaske et al) sets forth similar compositions that comprise aminoacrylates can be cured with UV devices having lamp outputs of 550 W/cm at cure rates of at least 100 meters/minute. Therefore the examiner deems that one of ordinary skill in the art at the time of the invention would have found it obvious to use a UV cure lamp having an output of 550 W/cm as suggested by Gaske et al. The motivation would have been a reasonable expectation of fully curing a coating composition in the absence of evidence to the contrary.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Felder et al (US 4,308,400) in view of Gaske (US 3,844,916).

Regarding claim 5, Felder et al teach a composition comprising the photosensitizer of claimed formula III (C8/L8-9, see 4,4'-bis-(α -hydroxy-isobutryl)-diphenyl ethane) and formula (II) (see col. 19, line 21), an ethylenically unsaturated compound (C11/L33, ethylene diacrylate C11/L39), fillers (C12/L58-61) and further photoinitiators (C12/L62-68). While the reference teaches the composition comprising an ethylenically unsaturated compound, even an acrylate, (C11/L33, ethylene diacrylate C11/L39), it does not specifically teach an aminoacrylate as the, ethylenically unsaturated compound.

Gaske discloses a radiation curable coating composition (C1/L4-5) containing a photoinitiator (C1/L32-33, see photosensitizer) and an ethylenically unsaturated compound being an aminoacrylate (C1/L17-42). Furthermore the reference discloses the composition to cure rapidly with minimum ultraviolet light and producing minimum fumes and vapors (C1/L8-11). The reference additionally discloses that the radiation polymerization is extended and speeded, as well as, scavenging oxygen preventing air inhibition of the coating composition by the presence of the tertiary amine of the aminoacrylate compound (C1/L34-42). Gaske and Felder et al teach analogous inventions related to radiation curable coatings comprising a photoinitiator and an ethylenically unsaturated compound. Applicant is reminded the courts have upheld that it is obvious to add a known ingredient to a composition for its known property--see *In re Linder* 173 USPQ 356. It would have been obvious to one of ordinary skill in the art at the time of the invention to use an aminoacrylate as the ethylenically unsaturated compound of the composition of Felder et al to increase the extent and speed of the polymerization of the composition, as well as, preventing air inhibition when exposed to UV light in the absence of evidence to the contrary and/or unexpected results.

Regarding claims 9, Felder et al teach applying the composition to a surface and curing the composition with UV light (see Example 4).

Regarding claim 20Felder et al teach the composition as a pigmented or unpigmented surface coating (C13/L19-27; varnish coating of metal sheeting, colorless varnish coating of paper).

Allowable Subject Matter

5. Claims 15 and 17-19 are allowed.

6. The following is an examiner's statement of reasons for allowance: The prior art, alone or in combination, fails to set forth a composition comprising an ethylenically unsaturated compound containing an aminoacrylate with a photoinitiator having the formula (V).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanza L McClendon/

Primary Examiner, Art

Unit 1796

SMc